

## RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ERIC ALLAN BIER

Appeal 2007-1105  
Application 09/731,912  
Technology Center 2100

MAILED

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PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Oral Hearing Held: May 23, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and ALLEN R. MACDONALD, Administrative Patent Judges.

ON BEHALF OF THE APPELLANT:

JOHN F. GUAY, ESQ.  
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34 The above-entitled matter came on for hearing on Wednesday, May  
35 23, 2007, commencing at 10:00 a.m., at The U.S. Patent and Trademark  
36 Office, 600 Dulany Street, Alexandria, Virginia.

1           JUDGE THOMAS: Good morning, sir. Have you been here before?

2           MR. GUAY: Pardon me?

3           JUDGE THOMAS: Have you been here before?

4           MR. GUAY: Not at this one. I was only at one of the ones at the old  
5        Crystal City.

6           JUDGE THOMAS: Okay. Well, things pretty much operate the  
7        same. You have -- you can step to the podium and present your arguments.  
8        You can use that clock as a guide. You are generally limited to 20 minutes,  
9        unless I extend the time.

10          MR. GUAY: Okay.

11          JUDGE THOMAS: Okay.

12          MR. GUAY: Okay. This invention deals with an editable, group  
13        editable, web page. And the idea itself is not new. There have been editable  
14        web pages before, but the core concept of this one was that it be --  
15        information that was contained within the web page that you needed to  
16        actually use to edit the web page.

17          And these features, I think, were brought out in the claim. I will use  
18        claim 1 as an example. Claim 1 is an example where we have an element  
19        selection device that selects a portion of an electronic document.

20          So we have the electronic document, and then we have a -- it says,  
21        where the selected portion includes at least one of template information and  
22        formatting information stored within the electronic document.

23          Now, template information and formatting information can be  
24        related. A template is like a structure of what can be put into a web page or  
25        portion of a web page. And formatting information could be an entry into a  
26        template, or it may not be. A template could have like spaces for dates or

1 names or things like that, whereas formatting would maybe deal with the  
2 font or the appearance, color and so forth.

3 Those are kind of important to keep in mind, that they are somewhat  
4 related but not necessarily the same.

5 And also that there is another term that has been thrown around a lot  
6 in this prosecution and it is the word "item".

7 "Item" sounds like it is a very broad term, but within the art, an item  
8 within a web page, actually means something. And it is usually the smallest  
9 entity of data you can put in. And that is mentioned by the Examiner in  
10 several places in his final rejection.

11 And he mentions that the prior art, Chang, teaches that you could edit  
12 a web page and change the items. And that is true. The thing is, an item is  
13 not a template. An item is -- not necessarily has anything to do with  
14 formatting.

15 And Chang does not teach anything about editing or formatting.

16 JUDGE THOMAS: What about changing a period to a question  
17 mark?

18 MR. GUAY: Pardon me?

19 JUDGE THOMAS: What about changing a period to a question  
20 mark? Is that a formatting thing? It certainly would be an item, wouldn't it?

21 MR. GUAY: That would be an item entry. You are talking about  
22 grammatical formatting?

23 JUDGE THOMAS: Yes. Quotes, periods, question marks, commas,  
24 the like. Don't those format the document?

25 MR. GUAY: In a more general sense, you could say that, but I think  
26 within the limited definition of what a format is here, and we actually --

1                   JUDGE THOMAS: Where is the limited definition in the claim?

2                   MR. GUAY: On -- let's see.

3                   (Pause.)

4                   MR. GUAY: I don't believe there was a formal definition in the  
5 specification for formatting. But I think within the art, and I think the  
6 Examiner is rejection also viewed it that way, that formatting meant it was a  
7 style type of designation that you would make for the document, and that  
8 any kind of entry would have to be displayed using that format.

9                   JUDGE THOMAS: Suppose all of the punctuation in the document  
10 is changed from blue to red? Isn't that a formatting sense in the sense of the  
11 art?

12                  MR. GUAY: That would be a format change, if you changed the  
13 color.

14                  JUDGE THOMAS: Okay.

15                  MR. GUAY: I agree.

16                  JUDGE THOMAS: Okay.

17                  MR. GUAY: But just entering text and grammatical periods,  
18 commas and things like that, I don't think would be reasonably considered a  
19 formatting within the context of this invention, and also to Chang and also to  
20 Giljum.

21                  JUDGE THOMAS: How about changing font types?

22                  MR. GUAY: Yes. That would be a formatting change.

23                  JUDGE THOMAS: Okay.

24                  MR. GUAY: It is something that usually is set by the web designer.  
25 He will set a style and then people would put their entries in and their entries  
26 would have to follow his styles.

1           And both of these documents -- I mean, the Giljum document does  
2 talk about allowing the users to change the style. I am not disagreeing there.  
3 The Examiner knows that. But he does it in a different way. He does it  
4 where he has a database that has all the style and the folders and all these  
5 different items -- I shouldn't say "items" --

6           (Laughter.)

7           MR. GUAY: These different entities are separated in different  
8 tables. And so, when the -- every time the web page is generated, it is done  
9 dynamically.

10           So, the point -- all these things from these different areas of the  
11 database to put together a web page, and then send it to the computer that  
12 wants to display it on a browser.

13           In our invention, we have all this information stored within the  
14 electronic document itself --

15           JUDGE MacDONALD: But isn't that the primary reference?

16           MR. GUAY: Pardon me?

17           JUDGE MacDONALD: Doesn't the primary reference include --

18           MR. GUAY: Chang?

19           JUDGE MacDONALD: Yes. Include that? I only saw the  
20 secondary reference as simply showing that it is desirable to be able to edit  
21 those things, which in fact I thought was also shown in Chang as the  
22 developer has control of those.

23           MR. GUAY: Yes.

24           JUDGE MacDONALD: So it is already known to edit and in fact --

25           MR. GUAY: Right.

1                   JUDGE MacDONALD: -- contrary to the argument in the brief that  
2 Chang does not teach editable format information or items or template items.  
3 It actually does. It's just not edited in the same way.

4                   MR. GUAY: Yes. It is not done in a group sense, in a group  
5 editable web page. It is done by the author before it is put on onto the web  
6 site for access.

7                   And the difference here between Chang was, Chang only allowed  
8 you to edit items, more or less. It did not mention editing any formatting  
9 part of any template. Or the template itself.

10                  That is what I was -- I have looked at Chang very carefully and it is -  
11 - I am not an HTML expert, but I went through that very carefully and didn't  
12 see any indication that he was teaching the editing where you select, as  
13 Chang does -- he does say to select an item, but the selected items, or the  
14 selected portion in Chang is not either a format --

15                  JUDGE MacDONALD: My concern being that Chang teaches an  
16 editing process --

17                  MR. GUAY: Right.

18                  JUDGE MacDONALD: -- with respect to content. Chang also  
19 teaches that it is known to edit these other items, these other pieces of  
20 information, template information, and formatting information, in a second  
21 way, and my concern being why is it not -- why isn't it obvious to then also  
22 extend Sparrow -- the Chang editing process -- to these other items?

23 Without anything more than Chang itself?

24                  MR. GUAY: Well, it is -- when you have a group editing  
25 environment, you have people at different locations, and so they are

1 downloading these documents and with Giljum, the way he handles it, he  
2 has – he just does it a different way. And that is the --

3 JUDGE MacDONALD: I agree with you, but I don't understand that  
4 that's relevant. To me, Giljum only is necessary to show, in addition to  
5 Chang, the desirability of being able to edit those particular pieces of  
6 information.

7 And in fact I think that is in your specification. You pretty much  
8 have pointed to that also, that the prior art recognizes that -- at page 2 of the  
9 specification, the last sentence of the background --

10 MR. GUAY: Uh-huh.

11 JUDGE MacDONALD: "With Sparrow" -- which is the software --  
12 the page author can change the layer of such a page, or the format of its  
13 items, by reading it into" -- and I will read the word in, standard -- "text  
14 editor or HTML authoring tool making the edits to the overall page."

15 So, the importance of being able to edit these items is already known,  
16 it's just what was not provided by Sparrow was the ability to edit it in the  
17 same way you are editing the content.

18 So, all I see here -- the point the Examiner was making may be a  
19 little bit not as clear as it could have been was that you are -- this is just an  
20 extension of the Sparrow process in an obvious -- the Sparrow system in an  
21 obvious way to other, already known pieces of information. That it is  
22 already known that it's desirable to edit those.

23 MR. GUAY: Yes, but I think the invention here -- and it is up for  
24 you to decide, of course -- but our client and myself, we believe that the fact  
25 that it is a self-contained document, does not require the database and the

1 management software and such, and the complexity that goes along with the  
2 Giljum.

3 And I think that the nice thing about this is that you can have this  
4 portable document that can be sent to several people and it is all self-  
5 contained.

6 JUDGE MacDONALD: And in fact I agree with you, because I was  
7 very impressed by the Chang reference, which is the earlier version of your  
8 invention. But all of those things are in there. And so, when I looked at it, I  
9 was wondering where the patent application was for this. And I don't see  
10 one, so I --

11 MR. GUAY: I can't speak to that.

12 JUDGE MacDONALD: Yes --

13 MR. GUAY: I do know it is the same client.

14 JUDGE MacDONALD: Yes. So, my question comes back to --  
15 once this has been disclosed to the public, isn't -- aren't we really seeing just  
16 an obvious improvement to what was previously disclosed?

17 That's a rhetorical question. You don't have to answer it.

18 MR. GUAY: Well, basically that is my presentation. So, I thank you  
19 for your time.

20 JUDGE MacDONALD: I do have one question --

21 MR. GUAY: Sure.

22 JUDGE MacDONALD: -- which is pretty much standard for 103  
23 rejections. Right now, do you think that KSR and Leapfrog from the CAFC  
24 have an impact on how this should be handled?

25 MR. GUAY: I think KSR would -- I was thinking about KSR last  
26 night.

1        When I was reading through this, because this was written before  
2    KSR was issued, and I probably would have done it little bit differently if I  
3    had done that beforehand. But several arguments were made that would go  
4    right on with KSR. They were discussing some hindsight issues.  
5    Obviously, I can't rely on that too much, anymore. So, I am sort of at a  
6    disadvantage here based on the decision. So, I am aware of that.

7            JUDGE MacDONALD: Okay. I have no other questions. Joe?

8            JUDGE RUGGIERO: No.

9            JUDGE THOMAS: No.

10          JUDGE MacDONALD: Thank you very much.

11          MR. GUAY: Thank you.

12

13          (Whereupon, the proceedings concluded.)